

Docket JP920000411US1

Appl. No.: 09/783,250  
Filed: February 14, 2001**REMARKS****INTRODUCTION:**

An Office action was mailed on December 7, 2004, reopening prosecution in response to an Appeal Brief mailed by Applicant on August 14, 2004.

The Office action presents a number of questions.

First, the question is presented whether the rejection is proper.

In the alternative, the question is presented whether finality of the rejection is proper.

In addition, if the rejection is proper, an issue is presented as to whether amendments submitted in the Appeal Brief have been entered.

**POSTURE:**

The first Office action in the present case rejected all claims and relied on one reference, U.S. Patent 6,067,639 (Rodriguez).

In a Reply A, claims were responsively amended to overcome the rejection.

The Examiner responded with a final rejection, citing an additional reference, U.S. Patent 6,173,440 (Darty).

The Appeal Brief of August 14, 2004, was responsively filed.

The Office action of December 7, 2004, indicates arguments of the Appeal Brief were persuasive and, therefore, the Rodriguez reference was withdrawn and a new ground of rejection was asserted based on a new reference, Telcordia Software Visualization and Analysis Toolsuite User's Manual, Chapter 3, ATAC: Overview.

The Office action of December 7, 2004, indicates the rejection is final.

**FIRST QUESTION PRESENTED: Is it proper to withdraw the Rodriguez reference and assert the new grounds of rejection instead of allowing claims in the case?**

The following does not state all of Applicant's arguments. If the present arguments are not deemed persuasive, Applicant reserves the right to formally request that the Appeal be reopened, at which time more extensive arguments may be presented in a new Appeal Brief. Of if the finality of the rejection in the present Office action is withdrawn, Applicant reserves the right to present more extensive arguments in a reply to the Office action.

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The present Office action indicates that the claims are allowable over the previously cited, now withdrawn, reference, Rodriguez. But instead of allowing the claims, the present Office action cites a new ground of rejection, based on the ATAC reference. When an Examiner has become convinced a previously rejected claim is allowable over prior grounds of rejection, the claim should be allowed, except for certain limited situations in which the claim may be subjected to a new ground of rejection. MPEP 706.7(e) ("The examiner may withdraw the rejection of finally rejected claims. If new facts or reasons are presented such as to convince the examiner that the previously rejected claims are in fact allowable . . . , then the final rejection should be withdrawn. "Although it is permissible to withdraw a final rejection for the purpose of entering a new ground of rejection, this practice is to be limited . . . "). The exception applies, that is, a new grounds of rejection is proper instead of allowance, when a certain test is met. MPEP 706.7(e) (" . . this practice is to be limited to situations where a new reference either fully meets at least one claim or meets it except for differences which are shown to be completely obvious.").

The newly cited reference, ATAC, does not fully meet at least one claim nor do so except for differences shown to be completely obvious. The present Office action does not even *contend* that ATAC meets this test. Therefore, the entering of this new ground of rejection is contrary to the stated procedure of MPEP 706.7, cited above, and should be reversed.

Further, the present Office action reapplies Darty, one of the two earlier applied references, in a way that is in direct opposition to arguments made about the very same reference in the Appeal Brief, which presented arguments acknowledged to be persuasive. As Applicant earlier stated, "Darty actually *teaches away* from [what is claimed in the present case] . . . that *all* lines of code in the program are grouped into functional blocks . . . Darty states that test points are associated with code blocks. Darty, col. 2, lines 25-28; see also col. 9, lines 28-32. The test points are "strategically placed" so that a block of code that is the "most probable" source of a failure may be identified, "depending on the number and placement of test points." Darty, col. 9, lines 24-38; see also col. 10, lines 3-10. This is contrary to the claims in the present application, that every line of code is assigned to a block and execution of every block is ensured. If Darty taught that every line was assigned to a block and every block was executed, then Darty would not discuss probabilities about which one of the blocks gives rise to an execution failure." Appeal Brief page 8.

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**SECOND QUESTION PRESENTED:** If it was proper to assert the new grounds of rejection instead of allowing the claims, should the rejection be final?

An Office action can be final every time after the first Office action, unless the an Office action introduces new grounds not necessitated by Applicant amendment. MPEP 706.07.

One amendment in the history of the case that necessitated new grounds of rejection should not give rise to a continuing condition for the application in which *new* grounds of rejection are necessary for every Office action in the case thereafter. MPEP 706.7 ("Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. *Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination*, i.e., either an allowance of the application or a final rejection.") (emphasis added). That is, every Office action after the first may be final; provided, however, that when grounds of rejection are changed without a *necessary* cause, that rejection cannot be final. MPEP 706.07(a) ("Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).").

The Examiner conducted a search for the claims amended in Reply A and already issued one final rejection for that amendment on the basis that the amendment necessitated the new grounds for rejection. The claims have not been amended since the last rejection in a manner that necessitates new grounds for rejection as compared to the last rejection.<sup>1</sup> So no amendments are

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<sup>1</sup> When preparing the Appeal Brief Applicant noticed some minor informalities in the claims that had not been previously addressed. Applicant therefore submitted amendments to correct the informalities in the Appeal Brief. But these amendments were trivial and did not necessitate new art.

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presented in the Appeal Brief that are new and different with regard to prior art as compared to the last examination of the application and that therefore necessitate a new grounds of rejection. Therefore a new final rejection is not proper.

Regarding "an amendment necessitating new grounds for rejection," the MPEP must be read so as to give meaning to the concept of necessity. A "necessary cause" for new grounds of rejection is when the claims change in a manner that cannot be "reasonably expected." MPEP 706.07(a) ("A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed."). Once Applicant has amended claims, a search has been done and a rejection issued for those amended claims, if Applicant does not again amend the claims in a manner that concerns the prior art, there is no *necessity* for yet another grounds of rejection. A "necessary" cause for new grounds of rejection no longer exists.

Further, the finality or non-finality of an Office action following reopening of prosecution after an appeal depends on whether the action could have been properly made final had it been entered prior to the appeal. MPEP 1208.02, Examiner Note 1. If, instead of an appeal and brief, Applicant had filed a response after final making the same substantive arguments that were made in the Appeal Brief (and not making any claim amendments of the prior art type), it would not have been permissible for the Examiner to withdraw the old ground of rejection, cite a new ground of rejection, and make the rejection final. MPEP 706.07(e) ("The examiner may withdraw the rejection of finally rejected claims. If new facts or reasons are presented such as to convince the examiner that the previously rejected claims are in fact allowable . . . , then the final rejection should be withdrawn.").

**THIRD QUESTION PRESENTED:**

If it was proper to assert the new grounds of rejection instead of allowing claims, were the amendments submitted in the Appeal Brief entered?

As explained above, the claims should be allowed, as amended. However, if new grounds of rejection are asserted instead of allowance, the former final rejection should be withdrawn, as

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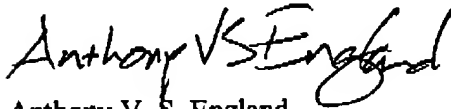
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also explained above. When a final rejection is withdrawn, all amendments filed after the final rejection are ordinarily entered. MPEP 706.7(e).

**REQUESTED ACTION**

For the above reasons, Applicant requests that the claims in the present case be allowed. Alternatively, Applicant requests that the finality of the rejection in the December 7, 2004, Office action be withdrawn. Applicant also requests a statement of status of the amendments submitted in the August 14, 2004 Appeal Brief.

Respectfully submitted,



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